

**REMARKS**

Claims 1 through 4 are currently pending in the application. Claim 4 has been withdrawn.

This amendment is in response to the Office Action of January 4, 2005.

**Double Patenting Rejection Based on U.S. Patent 6,475,831**

Claims 1 through 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 7 of U.S. Patent 6,475,831. In order to avoid further expenses and time delay, Applicants elect to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejections in compliance with 37 C.F.R. §1.321 (b) and (c). Applicants' filing of the terminal disclaimer should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejection. Attached is the terminal disclaimer and accompanying fee.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on Nishino (U.S. Patent 5,343,075)**

Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nishino (U.S. Patent 5,343,075).

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that the presently claimed inventions of presently amended independent claims 1 and 3 are not anticipated by the Nishino reference under 35 U.S.C. § 102 because the the Nishimo reference fails to identically describe, either expressly or inherently, each and every element of the claimed invention in as complete detail as is contained in the claims. Applicants

assert that the Nishino reference does not identically describe the elements of the claimed inventions set forth in presently amended independent claims 1 and 3 calling for “providing a cage enclosing at least two adjacent sides of the plurality of sides of each primary integrated circuit package of the stacked plurality of primary integrated circuit packages”. At best, the Nishino reference merely describes two contact plates, not a cage, the contact plates being located opposite each other on a substrate. Such is not the presently claimed inventions of presently amended independent claims 1 and 3. Therefore, such claims are allowable as well as dependent claim therefrom.

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### **Obviousness Rejection Based on Nishino (U.S. Patent 5,343,075)**

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishino (U.S. Patent 5,343,075). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants’ disclosure.

After carefully considering the cited prior art, the rejections, and the Examiner’s comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that the Nishino reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention of presently amended independent claim 3 because, at the least, the Nishino reference does not teach or suggest all of the claim limitations. For instance, the Applicants assert that the Nishino reference does not teach or suggest the claim limitation calling for for “providing a cage enclosing at least two adjacent sides of the plurality of sides of each primary integrated circuit package of the

stacked plurality of primary integrated circuit packages". At best, the Nishino reference merely describes two contact plates, not a cage, the contact plates being located opposite each other on a substrate. Such is not the presently claimed invention of presently amended independent claim 3. Therefore, such claim is allowable.

Applicants assert that claims 1 through 3 are clearly allowable over the cited prior art.

Applicants request the allowance of claims 1 through 3 and the case passed for issue.

Respectfully submitted,



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